circumstances." He made this unfortunate statement purporting to rely on *J. P. Berthelsen* v. *Director-General of Immigration, Malaysia & Ors.*[2] the passage at p. 138. In our view the passage should be read in the context of the paragraph in which it appears. *Berthelsen* was an immigration case. It dealt with the need to give a right to make a representation to an aggrieved person (in this case a foreign journalist) before his legitimate expectation (*i.e.* his employment pass) was to be withdrawn from him by the Immigration Authority. Such right of being heard must be given to him even though the grounds upon which the authority proposed to act were based on security considerations. In such case, whilst the authority was required to hear the representation from the aggrieved person, in no sense would it be bound to disclose any grounds or information which in its opinion would constitute security. This is entirely a matter for the authority concerned. *Berthelsen* is not an authority to say that the test of what constitutes security is an objective test; the case being entirely on a different fact-situation.

The learned judge was also in error to ignore the express provision of clause (3) of article 151 of the Constitution for by that clause the authority cannot be required to furnish facts whose disclosure would in its opinion be against national interest. But if facts are furnished voluntarily, exhaustively and in great detail as in this case for consideration of the court it would be naive to preclude the judge from making his own evaluation and assessment to come to a reasonable conclusion. In this case the learned judge thought it to be incredible that losses sustained by a public bank where the depositors also include members of the public at large could result in any organized violence by the soldiers. In fact, the person who alleged that was not even an army officer although subsection (6) of section 73 also empowers any member of the security force to act under that section. We found it difficult to disagree with the learned judge on his conclusion.

Appeal dismissed with costs.

Order accordingly.

Solicitors: *Sri Ram, Zulkifly & Kumar.*

FABRIQUE EBEL SOCIETE ANONYME v. SYARIKAT PERNIAGAAN TUKANG JAM CITY PORT & ORS.

[O.C.J. (Zakaria Yatim J.) May 25, 1987]
[Kuala Lumpur – Civil Suit No. C596 of 1984]

Civil Procedure – Application for final judgment – Conditions laid down – Infringement of trade mark – Requirements to be satisfied to prove infringement – Whether defendants have shown an arguable case – Trade Marks Act 1976, s. 38(1)(a) – R.H.C. 1980 O.14.

Trademarks – Infringement of – Requirements to be satisfied to prove infringement – Trade Marks Act 1976, s.38(1)(a).

In this case the plaintiff, the proprietor of the trade mark "EBEL" registered in Malaysia in respect of watches and part thereof, applied for summary judgment against the defendants in respect of infringement of the trade mark: (a) to restrain the defendants from infringing the plaintiff's registered trade mark; (b) for the delivery and destruction of all goods and articles that would offend against the injunction; and (c) for damages and costs.

Held: (1) the court has jurisdiction to enter summary judgment under Order 14 of the Rules of the High Court for an injunction;

(2) in order to suceed in its application for summary judgment under Order 14, the plaintiff must satisfy three conditions as laid down in the order: firstly, the defendants must have entered appearance; secondly, the statement of claim has been served on the defendants and, thirdly, the application for summary judgment must be supported by affidavit. In this case, the plaintiff has satisfied all the three conditions;

(3) in order to establish infringement of the trade mark, the plaintiff has to satisfy the following five requirements: (a) the defendants used the mark identical with the plaintiff's mark (b) the offending mark was used by persons who have not been authorised or licensed by the plaintiff (c) the defendants were using the offending mark in the course of trade (d) the defendants used the offending mark in relation to goods in respect of which the trade mark is registered (e) the defendants used the offending mark in such a manner as to render the use of the mark likely to be taken as being used as a trade mark. In this case, the plaintiff has satisfied all the five requirements;

(4) since the plaintiff is applying for summary judgment against the defendants on an action for infringement comparison must be made between the plaintiff's registered mark and the mark used by the defendants. Having made the comparison and having considered the evidence in the affidavits, the court was satisfied that the defendants had infringed the plaintiff's registered trade mark under section 38(1)(a) of the Trade Marks Act, 1976;

(5) from the affidavits and the statement of defence filed by the defendants, they have not disclosed any triable issue at all. Their defence is a bare denial without giving any particulars at all;

(6) the plaintiff's application for final judgment under Order 14 must therefore be allowed.

Cases referred to:

1) *Shell-Mex and BP. Ltd.* v. *Manchester Garages* [1971] 1 All E.R. 841, 842-845.
2) *Bank Bumiputra Malaysia Bhd. & Anor.* v. *Lorrain Osman & Ors.* [1985] 2 M.L.J. 236, 249.
3) *Coca-Cola Company* v. *Struthers (Williams) & Sons Ltd.* (1968) 85 R.P.C. 231, 242.
4) *Re Harker Stagg Limited's Trade Mark* [1954] 71 R.P.C. 136, 140.
5) *John Wallingford* v. *The Directors of Mutual Society* (1880) 5 A.C. 685.

CIVIL SUIT.

Lee Tat Boon for the plaintiff.

Saran Singh for the 1st, 3rd and 4th defendants.

S.C. Kwok for the 2nd and 5th defendants.

Cur. Adv. Vult.

Zakaria Yatim J. : This is an application by the plaintiff for final judgment under Order 14 of the Rules of the High Court 1980 against the first, second, third, fourth and fifth defendants for an injunction to restrain the defendants and each of them whether acting by themselves, their partners or proprietors (as the case may be), servants or agents or otherwise however from infringing the plaintiff's registered Trade Mark No. M/B41437. The plaintiff also asks the court for an order for the delivery up or destruction upon oath of all goods and articles in the possession, power, custody or control of each of the defendants that would offend against the injunction. The plaintiff further asks the court to order an enquiry to be made as to what damages (if any) have been sustained by the plaintiff by reason of the wrongful acts by each of the defendants and payment to the plaintiff of all sums found due upon taking such enquiry. The plaintiff also asks that the defendants pay to the plaintiff costs of this action and of this application to be taxed.

The plaintiff is a company incorporated under the laws of Switzerland and having its registered office at No. 133 rue de la Paix, La chaux-do-Fonds, Switzerland which territory is outside the scheduled territories as defined by the Exchange Control Act 1953. In the statement of claim the plaintiff avers that it is the proprietor of the Trade Mark "EBEL" with device registered under No. M/B41437 in Malaysia in respect of watches and parts thereof. The said mark has at all material times been valid and subsisting.

The first defendant carries on business as a firm at Ground Floor, Jalan Chow Kit, Kuala Lumpur selling, *inter alia*, watches. The second defendant carries on business as a firm at L9091, Sungei Wang Plaza, Kuala Lumpur and is engaged in the manufacture and sale of watches and/or components thereof. The third defendant carries on business as a firm at Ground Floor, I-C, Jalan Chow Kit, Kuala Lumpur and is engaged in the manufacture and sale of watches. The fourth defendant is engaged either on his own account or as agent for the first defendant in the sale of watches. The fifth defendant is engaged either on his own account or as agent for the second defendant in the sale of watches.

In paragraph 6 of the statement of claim the plaintiff alleges that the defendants and each of them have, since the registration of the said Trade Mark and before the issue of the writ in the present action, infringed the registered Trade Mark "EBEL" by using in the course of trade in Malaysia in relation to watches not the watches of the plaintiff, the plaintiff's registered Trade Mark "EBEL" or colourable imitation thereof. The plaintiff also alleges that the use of the imitation watches is calculated to be passed off as and for the watches of the plaintiff. The plaintiff claims that it had suffered loss and damage. The prayers contained in the application for summary judgment are also included in the statement of claim.

It is clear that the court has jurisdiction to enter summary judgment under Order 14 of the Rules of the High Court for an injunction. In *Shell-Mex and BP Ltd.* v. *Manchester Garages Ltd.*[1], Lord Denning M.R. said, "I see no reason whatever why a plaintiff cannot go straight to the judge and ask for summary judgment under RSC Order 14 for an injunction...The plaintiffs were quite entitled to go under RSC Order 14 to the judge for an injunction."

Mr. Lee Tatt Boon, counsel for the plaintiff, said that he was asking for summary judgment for injunction in respect of infringement only and not in respect of passing-off. In the statement of claim, the plaintiff is praying for injunction in respect of both infringement and passing-off. Mr. Lee submitted that he was entitled to ask the court for summary judgment for injunction in respect of infringement only. I agree with Mr. Lee's submission. Order 14 rule 1 of the Rules of the High Court 1980 enables the plaintiff to proceed under Order 14 on one or more of several claims included in the writ, instead of having to proceed on all the claims included in the writ. See *The Supreme Court Practice*, 1985, v.1, p. 132.

In order to succeed in its application for summary judgment under Order 14, the plaintiff must satisfy three conditions as laid down in Order 14. Firstly, the defendants must have entered appearance. Secondly, the statement of claim had been served on the defendants. Thirdly, the application for summary judgment must be supported by affidavit.

With regard to the first condition, it is clear that the first, third and fourth defendants had filed their memorandum of appearance in the court's registry on May 5, 1984. The second and fifth defendants filed their memorandum of appearance on March 22, 1984.

The next question is whether the statement of claim had been served on all the six defendants. In his affidavit affirmed on June 12, 1984, Mr. Ho Kam Phaw, a legal assistant employed by the firm of solicitors representing the plaintiff, averred that on March 13, 1984 he and two others from the same firm of solicitors visited the premises of the first defendant and met a lady, Madam Tham Yin May, who was in charge of the business at the premises. Mr. Ho served, *inter alia,* the writ of summons and the statement of claim on Madam Tham, who accepted service of the documents. Mr. Ho explained the contents of the documents to her. Mr. Ho further averred that on March 21, 1984 he visited the same premises and there he met the fourth defendant. He served the same documents including the writ of summons and the statement of claim on the fourth defendant and explained the contents of the documents to him. In another affidavit affirmed on June 12, 1984, Mr. Kok Chee Kheong, another legal assistant from the same firm of solicitors, averred that on March 13, 1984 he went to the premises of the second defendant and served on the representative of the second defendant the writ of summons (the writ of summons and the statement of claim in this action form one document). Mr. Kok then explained to her the contents of the documents served on her. In another affidavit affirmed on April 26, 1984 by Encik Shamsul Bahrain, another legal assistant from the same firm of solicitors, the deponent averred that on March 13, 1984 he served a copy of the writ of summons on a person who was in control of the management of the business of the third defendant at the principal place of business of the third defendant. The fifth defendant was served with a copy of the writ of summons in this action and other documents on March 13 by a legal assistant from the same firm of solicitors. The contents of the said documents were explained to the fifth defendant. See the affidavit of Mr. Yip Fook Thai affirmed on June 12, 1984. From the affidavits I have referred to, it is evident that the statement of claim had been duly served on the first, second, third, fourth and fifth defendants.

With regard to the third condition, the plaintiff filed an affidavit in support of the application for summary judgment. The affidavit was affirmed by Mr. Lee Tatt Boon on June 13, 1984. In his affidavit, Mr. Lee averred that he was authorised by the plaintiff to affirm the affidavit. In paragraph 2 he stated that the plaintiff's application for summary judgment was in respect of trade mark infringement. He averred that the plaintiff was at the commencement of this action justly and truly entitled to the injunction referred to in the statement of claim for the infringement of the plaintiff's registered trade mark by the defendants. He then referred to the plaintiff's claim in respect of trade mark infringement by the defendants as set out in the statement of claim. In paragraph 4 he averred that he verily believed that there was no defence to the plaintiff's claim for infringement of the plaintiff's trade mark.

In my view, Mr. Lee's affidavit has complied with the requirements of rule 2 of Order 14. See *The Supreme Court Practice,* 1985, *(supra)* p. 134. In his affidavit he verified the facts on which part of the claim to which the application relates is based. He also stated his belief that there was no defence to the plaintiff's claim for infringement.

I shall now examine the merits of the application.

The plaintiff was the registered proprietor of trade mark "EBEL" with device registered under No. MB 41437 in the Federation of Malaya in Class 14 in respect of watches and parts thereof. The said mark was renewed till March 11, 1985 and was at all material times valid and subsisting. The question for the court to consider is whether the plaintiff's case on infringement of its trade mark had been made out?

The relevant provision of the law relating to infringement of trade mark is section 38(1)(a) of the Trade Marks Act 1976. The section states:

"A registered trade mark is infringed by a person who, not being the registered proprietor of the trade mark or registered user of the trade mark using by way of permitted use, uses a mark which is identical with it or so nearly resemb-

ling it as is likely to deceive or cause confusion in the course of trade in relation to goods in respect of which the trade mark is registered in such a manner as to render the use of the mark likely to be taken either –

(a) as being used as a trade mark."

In order to establish infringement of a trade mark under section 38(1)(a), the plaintiff has to satisfy the following five requirements:

(1) The defendants used the mark identical with the plaintiff's mark.

(2) The offending mark was used by persons who have not been authorised or licensed by the plaintiff.

(3) The defendants were using the offending mark in the course of trade.

(4) The defendants used the offending mark in relation to goods in respect of which the trade mark is registered.

(5) The defendants used the offending mark in such a manner as to render the use of the mark likely to be taken as being used as a trade mark.

With regard to the first requirement the question is whether the defendants used the mark identical with the plaintiff's mark "EBEL"? According to the plaintiff's affidavit affirmed on March 12, 1984, the plaintiff's investigator visited the first defendant's premises at Ground Floor, 18, Jalan Chow Kit, Kuala Lumpur on February 28, 1984. A meeting was held between the investigator and the fourth defendant. At the meeting, reference was made to some watches on display at the window. None of the watches were found to depict any brand names although the designs were identical to models recognized as "DUNHILL", "LONGINES", "ST. DUPONT", "OMEGA" and "EBEL". The fourth defendant told the investigator that trade marks could be applied to the watches, including the trade mark "EBEL". The fourth defendant promised to supply samples of watches with "EBEL" trade mark. The following day the fourth defendant produced to the investigator two samples of watches depicting the "EBEL" trade mark. The fourth defendant admitted that the task of applying the trade mark was given to small printing companies. The affidavit further stated that on February 18, 1984, the investigator visited the third defendant's premises at Ground Floor, 1-C, Jalan Chow Kit, Kuala Lumpur. A meeting was held with the wife of the sixth defendant. She showed the investigator a watch with the mark "EBEL". The next day the investigator obtained two samples of watches bearing the "EBEL" trade mark from the wife of the sixth defendant. The watches bearing the said mark were found to be counterfeit. She said she could supply unlimited quantities of such watches. But she refused to reveal the identity of the sub-contractors who printed the mark. She said that stringent precaution had to be taken in the event of legal action. According to the affidavit, the plaintiff's investigator went to visit the second defendant on February 27, 1984. The second defendant's stall was situated outside 468, Jalan Tuanku Abdul Rahman, Kuala Lumpur where a wide range of watches was displayed including those depicting the mark "EBEL". The agent also found several watches from the fifth defendant including watches depicting the mark "EBEL". All these watches were counterfeit.

With regard to the second requirement, paragraph 45 of the same affidavit stated that "though the said watches all bear the plaintiff's trade mark "EBEL" they are not the watches of the plaintiff and neither are they manufactured by the plaintiff." All the plaintiff's watches have their own identification marks such as the model and serial numbers on the back of the case. From the plaintiff's affidavit it is implicit that the defendants had not been authorised or licensed by the plaintiff to use the trade mark on counterfeit watches.

With regard to the third and fourth requirements, it is clear from the plaintiff's affidavit that the defendants used the offending mark in the course of trade. The investigator bought the counterfeit watches from the defendants. From his investigation he discovered that the defendants had large supplies of the counterfeit watches for sale at a very cheap price. The offending mark was found only on watches. The certificate from the Trade Mark Registry dated March 6, 1984 clearly states the plaintiff's mark "EBEL" is used in respect of watches manufactured by the plaintiff.

With regard to the fifth requirement, it is clear from the affidavit and the documents exhibited thereto that the defendants used the mark "EBEL" on their counterfeit watches in such a manner as to render the use of the mark as being used as a trade mark.

Perhaps I should mention here that on March 13, 1984, on the *ex parte* application by the plaintiff, I granted an order of interim injunction and an

Anton Piller order against the defendants. The defendants applied to set aside the *ex parte* order but their applications were dismissed with costs on October 18, 1985. When I granted the Anton Piller order, I was satisfied that the plaintiff had a strong *prima facie* case against the defendants. It is essential that in granting an Anton Piller order the court must be satisfied that the plaintiff has established a strong *prima facie* case against the defendants. See *Bank Bumiputra Malaysia Bhd. and Anor.* v. *Lorrain Osman & Ors.*[2]

So far, on the question of infringement, I have relied on affidavit evidence. Since the plaintiff is applying for summary judgment against the defendants on an action for infringement, comparison must be made between the plaintiff's registered mark and the mark used by the defendants: *Coca Cola Company* v. *Struthers (Williams) and Sons Ltd.*[3] Since the court has to decide whether there is infringement or not in the instant case, it is the duty of the court to make the comparison. See *Re Harker Stagg Limited's Trade Mark.*[4]

During the hearing of this application in open court, I did in fact examine and compare the plaintiff's watch with the registered trade mark "EBEL" with the defendants' watch bearing the same mark. The following is my finding: On the plaintiff's watch below the Roman figure XII is the logo and the word "EBEL". The defendants' watch bears the same logo and mark with the word quartz. At the back of the defendants' watch I found no mark or words written on it. At the back of the plaintiff's watch the model number and the serial number are written on it. In front of the plaintiff's watch there are five screws, whereas the defendants' watch has only four screws. On the buckle of the plaintiff's watch there is a logo but there is no such mark on the defendants' watch.

Having made the comparison and having considered the evidence contained in the affidavits, I find that there is a likelihood that the plaintiff will succeed at the trial of the action on infringement.

The question for the court to consider now is whether the defendants have shown that they have an arguable case in their defence.

The first and fourth defendants filed in affidavit affirmed on August 11, 1986. In this affidavit the two defendants merely denied that they were dealing in counterfeit watches. They stated that they had a good defence and that "there are numerous triable issues of fact and law", but they did not state what the "good defence" was or what the "numerous triable issues" were. In this affidavit the two defendants referred to their earlier affidavit affirmed on July 7, 1984. This earlier affidavit merely contained denials by the first and fourth defendants. The affidavit made no reference to paragraphs 42, 43 and 44 of the plaintiff's affidavit affirmed on March 12, 1984. In these paragraphs the plaintiff averred that its investigator visited the fourth defendant's business premises and met the fourth defendant, who admitted that he was dealing with counterfeit watches bearing the "EBEL" mark. In paragraph 18 of the defendants' affidavit, the first and fourth defendants merely denied all the allegations made against them. In my opinion, these two affidavits do not raise any arguable case at all. They do not contain any particulars at all. In *John Wallingford* v. *The Directors of the Mutual Society,*[5] Lord Blackburn, in his judgment at p. 704, said:

> "I think that when the affidavits are brought forward to raise that defence, they must, if I may use the expression, condescend upon particulars. It is not enough to swear, "I say I owe the man nothing". Doubtless, if it was true, that you owed the man nothing, as you swear, that would be a good defence. But that is not enough. You must satisfy the judge that there is reasonable ground for saying so. So again, if you swear that there was fraud, that will not do. It is difficult to definie it, but you must give such an extent of definite facts pointing to the fraud as to satisfy the judge that those are facts which make it reasonable that you should be allowed to raise that defence. And in like manner as to illegality, and every other defence that might be mentioned.
>
> So looking at the affidavits (they are very long and I will not go through them) which were used before Mr. Justice Manisty, I think that in none of those particulars did the appellant satisfy the burden that was cast upon him. He makes general statements of fraud, but nowhere does he condescend upon any particular of fraud, such as in my mind, if I had been in Mr. Justice Manisty's place, would have made me think that it was at all fit that he should be allowed to defend upon that ground. There are long statements resulting in saying that this society was illegal upon various grounds, which I cannot follow at all. One ground, among others, is, because there was a drawing of lots on one occasion, therefore it was illegal as coming under the Lottery Acts. I cannot think that that was a good ground of defence".

The third defendant did not file an affidavit in reply to the plaintiff's application for summary judgment. He filed an affidavit earlier on in support of his application to set aside the injunction and the Anton Piller order. The third defendant cannot rely on this affidavit now as no notice had been given under Order 32 rule 13(b) of the

Rules of the High Court. In any event this affidavit is a bare denial against the allegations made against the third defendant. It has not disclosed any arguable case.

The first, third and fourth defendants filed a statement of defence on July 7, 1984. Here again, the defence is a bare denial of the allegations made by the plaintiff. There is absolutely no issue raised in the defence for trial.

The second and fifth defendants filed an affidavit affirmed on December 31, 1984. This affidavit, too, is a bare denial of the plaintiffs allegations: they denied having infringed the plaintiff's trade mark, they denied manufacturing counterfeit watches. Attached to this affidavit is a draft statement of defence by the second and fifth defendants. Here again the statement of defence contains a bare denial.

From the affidavits and the statement of defence filed by the defendants, they have not disclosed any triable issued at all. Their defence is a bare denial without giving any particulars at all. See *John Wallingford's* case *(supra).*

In the circumstances, I allow the plaintiff's application for final judgment under Order 14 against the first, second, third, fourth and fifth defendants for:

(1) an injunction to restrain the said defendants and each of them whether acting by themselves, their partners or proprietors, servants or agents or otherwise howsoever from infringing the plaintiff's registered trade mark No. M/B 41437;

(2) for the delivery up or destruction upon oath of all goods and articles in the possession, power, custody or control of each of the defendants, the manufacture, use or sale of which by any of the defendants would offend against the foregoing injunction;

(3) that an enquiry be made as to what damages (if any) have been sustained by the plaintiff by reason of the wrongful acts by each of the five defendants and payment to the plaintiff of all sums found due upon taking such enquiry; and

(4) the defendants will pay to the plaintiff costs of this action and of this application.

Order accordingly.

Solicitors: *Skrine & Company; Saran Singh Co., Kwok & Company.*

LEE KIM LUANG v. LEE SHIAH YEE

[O.C.J. (K.C. Vohrah J.) June 1, 1987]

[Temerloh — Civil Suit No. 13 of 1985]

Civil Procedure – Fraud – Pleadings – Mere allegations of fraud insufficient – Particulars of fraud must be pleaded – Standard of proof higher than that in civil action – Onus to prove on person claiming fraud – R.H.C. 1980, O.18 r.12.

Land Law – Transfer of land to "Lee Yeak" – Identity of "Lee Yeak" in dispute – Fraud – Mere allegations of fraud insufficient – Standard of proof higher than in civil action – Onus to prove on person claiming fraud.

Evidence – Dispute as to identity – Inscription on tombstone admissible to show "the existence of any relationship by blood, marriage or adoption between deceased persons" – Evidence Act 1950, s.32(f).

In 1924, two plots of land, now amalgamated, were transferred to one "Lee Yeak." The transferor in both cases was Goh Ching. One of the main questions was whether she transferred both the lots to her husband, Lee Chan, or to their son, Lee Teow Kee. Goh Ching, her husband Lee Chan and their son Lee Teow Kee are now dead.

The plaintiff claimed that Lee Chan was known as "Lee Yeak" or "Lee Aik" and that the amalgamated property was therefore Lee Chan's. The defendant, however, disputed that and claimed that Lee Teow Kee, his father, was known as "Lee Yeak" or "Lee Aik."

Lee Chan died intestate in 1931. When letters of administration in respect of this estate were granted to his widow Goh Ching and their son Lee Teow Kee, this amalgamated property did not appear in the list as one of the assets of Lee Chan's estate.

In 1952 Lee Teow Kee died. The land was instead included as an asset of his estate.

The plaintiff, one of Lee Chan's sons, asserted that the said property was Lee Chan's. The plaintiff alleged fraud on the part of the defendant, one of Lee Teow Kee's sons, and sued him in his capacity as administrator of the estate of Lee Teow Kee. The defendant denied the allegation of fraud. The plaintiff relied, *inter alia*, on the inscription on his father's tombstone in Chinese characters which read "Lee Jit Chan alias Lee Chin Aik." The question before the court was whether the statement relating to the alias is a statement of a relevant fact relating to "the existence of any relationship by blood, marriage or adoption between deceased persons" within the meaning of section 32(f) of the Evidence Act 1950.

Held, dismissing the plaintiff's claim: (1) the inscription on the tombstone relating to the alias is admissible. But it only shows that Lee Chan had an alias of "Lee Chin Aik" not "Lee Aik";

(2) in this case there was merely a general allegation of fraud and the pleadings stand mute as to the circumstances relied upon as constituting the alleged fraud. A general allegation of fraud is insufficient even to amount to an averment of fraud of which any court ought to take notice;